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349 479

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/349,479	12/02/94	BORDER	W PLA1245

EXAMINER
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18N2/1125

CATHRYN CAMPBELL  
CAMPBELL & FLORES LLP  
4370 LA JOLLA VILLAGE DRIVE  
SUITE 700  
SAN DIEGO CA 92122

ART UNIT	PAPER NUMBER
1804	52

DATE MAILED: 11/25/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 8/22/97

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 21-25 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
☐ Claim(s) \_\_\_\_\_ is/are allowed.  
☒ Claim(s) 21-25 is/are rejected.  
☐ Claim(s) \_\_\_\_\_ is/are objected to.  
☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.  
☐ The specification is objected to by the Examiner.  
☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.  
☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892  
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 52  
☐ Interview Summary, PTO-413  
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948  
☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

This application should be reviewed for errors.

Claims 21-25 are active and examined in this office action.

The provisional rejection of claims 21-25 under the judicially created doctrine of obviousness type double patenting as being unpatentable over copending application serial nos. 07/803,285 and 07/467,888 is maintained. Applicants have not addressed the rejection. Further, the examiner has become aware of copending application serial no. 08/407,942 which has overlapping claims.

Claims 21-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending application serial no. 08/407,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to suppressing extracellular matrix activity using 'agents'.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The rejection of claims 21-25 under 35 USC 112, first and second paragraphs, is maintained. Applicants have not addressed

the rejection regarding the word "agent". Further, applicants have addressed the issue of the animal model in relation to TGF-beta pathologies but the claims are not so limited to any disease in particular. Applicant's arguments are not commensurate with the scope of the claims.

The rejection of claims 21-25 under 35 USC 112, second paragraph, regarding the word "a" is withdrawn in view of the amendmenst to the claims.

The rejection of claims 21 and 24 under 35 USC 103 as being unpatentable over Connor is maintained. Applicants have not argued the rejection and the submitted references do not address the in vivo treatment issue.

The rejection of claims 22 and 23 under 35 USC 103 as being unpatentable over Connor as applied to claims 21 and 24 above and further in view of McKay is maintained. Applicants have not argued the rejection and the submitted references do not address the in vivo treatment issue.

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

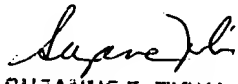
A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO FAX center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (30 November 15, 1989). The CM1 official Fax Center number is (703) 305-3014 or (703) 305-4242.

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Art Unit: 1804

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Suzanne Ziska, Ph.D., whose telephone number is (703)308-1217. In the event the examiner is not available, the examiner's supervisor, Jasmine Chambers, Ph.D., may be contacted at phone number (703) 308-3153.

  
SUZANNE E. ZISKA  
PRIMARY EXAMINER  
GROUP 1800